



AP 13621

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PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/833390
Filing Date	04/11/2001
First Named Inventor	Triola
Group Art Unit	3621
Examiner Name	Backer, Firmin
Attorney Docket Number	CRT044US

Total Number of Pages in This Submission

ENCLOSURES (check all that apply)

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☒ Amendment / Reply
- ☒ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Assignment Papers (for an Application)
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____

- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):

Petition from designation of action as "final"

Remarks

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OCT 10 2002

GROUP 3600

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Eugene H. Valet
Signature	<i>Eugene H. Valet</i>
Date	Oct. 01, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 10/01/02

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Signature	<i>Eugene H. Valet</i>	Date	10/01/02

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#10
3/24/03
AFTER FINAL
me

PATENT APPLICATION
DOCKET NO.: CRT044US

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

10 GROUP ART UNIT: 3621
EXAMINER: Backer, Firmin
SERIAL NO.: 09/833,390
15 CONF. NO.: 3769
INVENTOR(S): C. Richard Triola
FILING DATE: 04/11/2001
20 TITLE: Method and Apparatus for Processing Escrow Transactions

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PETITION
25

To: THE ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON D.C. 20231

30 This paper is filed in replay to the Final Office Action, date mailed 08/13/2002. Applicants hereby request relief for the designation of the Action as "Final."

1. The Office has issued a second Action, designating it "Final." This second Action, at page 2, in para. 1 and 2 thereof, cites for the first time U.S. Patent No. 6,304,860 (Martin, Jr. et al.), alleging claims 1-20 (all claims) are anticipated under 35 U.S.C. 102(c). The Action
35 then has five (5) pages of argument in thirteen (13) individual paragraphs, posing various allegations against specific claims as amended by the applicant in response to the first Office Action, date mailed 05/02/2002.

40 MPEP 706.07(a) is clear: "...second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated

by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. . . ."

At page 2 of the Action, the examiner states: "Applicant's arguments with respect to claims
5 1-20 have been considered but are moot in view of the new ground(s) of rejection."

At page 6 of the Action, the Examiner states: "Applicant's amendment necessitated the new ground(s) of rejection presented in the Office action [sic]."

10 Neither statement is correct.

2. Applicant's response to the First Office Action included detailed arguments regarding the inapplicability of the cited reference - U.S. Pat. No. 6,343,738 (Ogilvie) - then cited under Section 102(e), and minimal amendments. For example, claim 1 was amended inter alia
15 only by an addition to the preamble: "Apparatus for real estate escrow transactions, comprising:. . . ." This feature related directly to the majority of applicant's specification and the exemplary embodiments, particularly the entire flow chart of FIGURE 1A-1C and the exemplary computer screen illustrations of the other FIGURES. Otherwise, the claims remain substantively unchanged. There is clearly in this case no "Switching from one
20 subject matter to another in the claims presented by applicant. . . ." MPEP 706.07.

However, there is now a switch by the Examiner of the reference cited. Ogilvie was dropped (Ogilvie only deals with brokering the transfer of ephemeral "digital goods"). Cited Martin Jr. et al. deals only with using ATM machines. Neither deals with applicant's invention. Martin Jr. et al. clearly raises new issues. There simply is no reasonable argument that in such an
25 instance applicant's amendment necessitated the new reference. Considering the application and claims as a whole, if the newly cited Martin, Jr. et al. reference is relevant now (which it is not, as argued in the After Final Reply filed herewith), it must have been relevant previously. Applicant has been afforded no opportunity to argue and amend, if appropriate, with respect to this new ground for rejection.

30

3. The Action fails to provide an indication that the Examiner has considered applicant's Information Disclosure submission of May 1, 2002, 1st Class Mail certified, including PTO-

1449 and U.S. Pat. No. 5,615,268 (Bisbee). Consideration and a signed copy of the form PTO-1449 should have been made by the Examiner. This issue is still outstanding.

4. The MPEP is specific: "Before final rejection is in order a clear issue should be
5 developed between the examiner and applicant." MEPE 706.07, first sentence. ". .
.applicant is entitled to a full and fair hearing, and that a clear issue between applicant and
the examiner should be developed." The First Action reference, Ogilvie, in the main had to
do with an automated brokering system, e.g., auctions of "digital goods"; the Second Action
reference, Martin, Jr. et al., in the main has to do with using an ATM for debt payment.
10 Applicant's invention has to do with complete, complex, fully automated, tangible property
escrow processes. Neither reference even comes close to suggesting, much less
anticipating, applicant's invention. It is evident that no "clear issue" is defined yet in this
prosecution.

15 Furthermore, applicant will be both legally prejudiced and financially prejudiced - by
requirement of fees and the like to continue other prosecution or appeal routes - should the
Action be allowed to stand as "Final."

It is respectfully petitioned that the designation of the Action as "Final" be withdrawn.

20 Dated: OCT. 1, 2002

Respectfully submitted,



Eugene H. Valet
Reg. No. 31435



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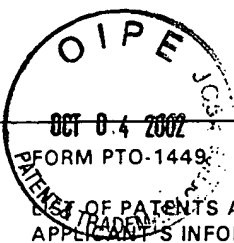
TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/833,390	
	Filing Date	04/11/01	
	First Named Inventor	Triola, C.R.	
	Group Art Unit	2131	
	Examiner Name	Baron	
Total Number of Pages in This Submission		Attorney Docket Number	CRT044US

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
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<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): USPN 5,615,268
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
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<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD Number of CD(s)	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Office of Eugene H. Valet
Signature	<i>Eugene H. Valet</i>
Date	May 1, 2002

CERTIFICATE OF MAILING			
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Typed or printed name	Eugene H. Valet	Date	May 1, 2002
Signature	<i>Eugene H. Valet</i>		

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OCT 04 2002

FORM PTO-1449

OFFICE OF PATENTS AND PUBLICATIONS FOR
APPLICANTS INFORMATION DISCLOSURE
STATEMENT

(Use several sheets if necessary)

ATTY. DOCKET NO.

CRT044US

APPLICATION NO.

09/833390

CONFIRMATION NO.

APPLICANT

Triola, CR

FILING DATE

04/11,01

GROUP

2131

REFERENCE DESIGNATION

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS
	1A	5615268	Mar. 25, 1997	Bisbee et al.	380	25
	1B					
	1C					
	1D					
	1E					
	1F					
	1G					
	1H					
	1I					
	1J					
	1K					

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FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	TRANSLATION	
							YES	NO
	1L							
	1M							
	1N							
	1O							
	1P							

OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

	1Q	
	1R	
	1S	

COPY

EXAMINER

DATE CONSIDERED